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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,151	08/21/2006	Kyoichi Takeda	129093	5738
25944 7590 02/24/2011 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
LOVE, TREVOR M				
ART UNIT		PAPER NUMBER		
1611				
NOTIFICATION DATE		DELIVERY MODE		
02/24/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/590,151

Applicant(s)

TAKEDA ET AL.

Examiner

TREVOR M. LOVE

Art Unit

1611

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 February 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4(3+1) months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-3, 5, 8 and 10-12
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/T. M. L./
Examiner, Art Unit 1611

/David J Blanchard/
Primary Examiner, Art Unit 1643

Continuation of 11, does NOT place the application in condition for allowance because: The rejection of claim 12 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is maintained.

The rejection of claims 1-3, 5, 8, 10-12 under 35 U.S.C. 103(a) as being unpatentable over Gruning et al (U.S. Patent number 6,242,499, Patent issued Jun. 5, 2001) is maintained.

Applicant argues in the after-final filed 02/15/2011 that the amendment to claim 12 fully complies with the written description requirement. Applicant further identifies that several portions of the specification which Applicant believe provide support. However, Applicant's argument is not found persuasive in view of the evidence provided by the Examiner. Specifically, even Applicant in the response filed 02/15/2011 states that "one [of] ordinary skill in the chemical arts would know that it is rare, if not impossible, for raw materials to have 100% purity, especially materials in the glycerin family of chemicals" (see remarks, paragraph bridging pages 4 and 5). Therefore, Applicant themselves identify that Applicant would not reasonably have written description for something which Applicant claims to be "rare, if not impossible".

Applicant further argues that the 103 rejection is improper. Specifically, Applicant argues that the composition of Gruning is not equivalent to the composition of the instant invention, wherein Applicant further argues that there is no motivation to modify the teachings of Gruning. Applicant's argument is not found persuasive since the claims are broadly drawn to a "hydroxyl compound" having a hydroxyl value in the range of 30 to 80 and a molecular weight of in a range from 2000 to 7000, which is obvious in view of Gruning. Second, the phrase "obtained by reacting diglycerin with isostearic acid" based on the disclosure and/or definitions provided in the specification is inclusive to other glycerols being present, not just diglycerol, consistent with the teachings of Gruning. Note for instance the use of diglycerol by Solvay (see attached Solvay document), wherein other glycerols are present. In view of the structures being the same, the viscosity would further have necessarily been the same. It is noted that MPEP 2112.01 states: "Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)." Further, Applicant's argument that motivation does not exist is not found persuasive since one would have been motivated to vary the molar ratio of the components in order to arrive at a desirable amount of esterification. Furthermore, the molecular weight of the composition depends on the intended use and is readily varied. It is noted the discussion above with regard to claims 6-8 wherein it is identified that both the instant claims and Gruning are teaching a composition with the same components, reacted in the same way, with the same hydroxyl values, and the same acid values, wherein it is also noted that both compositions are being used in cosmetics. Specifically, with the final product being the same, one would have been motivated to vary the amounts of the polyglycerol in order to achieve superior esterification.

Therefore, Applicant's arguments are not found persuasive.